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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/424,521 02/15/00 NIELSEN P ISIS-3070

JOSEPH LUCCI  
WOODCOCK WASHBURN KURTZ  
MACKIEWICZ & NORRIS  
ONE LIBERTY PLACE 46TH FLOOR  
PHILADELPHIA PA 19103

HM12/0710

EXAMINER

LARSON, T

ART UNIT

PAPER NUMBER

1635

DATE MAILED:

07/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Advisory Action</b>	Application No. 09/424,521	Applicant(s) NIELSEN ET AL.	
	Examiner Thomas G. Larson, Ph.D.	Art Unit 1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 June 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the \_\_\_\_\_ application in condition for allowance because: Please refer to attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 15-52.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

ATTACHMENT TO ADVISORY ACTION

1. This is an attachment to the advisory action, paper no. 13.
2. The amendment to the specification updating the continuing data has been entered as not pertaining to claimed subject matter.
3. Applicant's arguments filed 6/22/01 have been fully considered but they are not persuasive.

With respect to the rejection of claims 1-22 and 25-38 under 35 USC 103(a), applicant alleges that "...none of the cited secondary references so much as mention adamantyl groups or derivatives thereof." Applicant's attention is respectfully directed to the Haas et al. document as set forth in the Office action mailed 8/2/00.

With respect to the rejection of claims 23, 24, and 39-52 under 35 USC 112, 1<sup>st</sup> paragraph, applicant alleges that "...the examiner mistakenly believes that the specification must enable the therapeutic application of the claimed invention." It is submitted that the scope of the claims consists of or comprises therapeutic embodiments (e.g. pharmaceutical compositions, methods of treating an animal). Therefore, the specification must enable therapeutic subject matter or else it fails to enable the invention as claimed. Moreover, the specification must enable those skilled in the art how to make and use *the full scope* of the claimed invention. Note

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MPEP 2164.08. It is noted that a *prima facie* case of lack of enablement was arrived at by following the analysis set forth in *In re Wands* in the Office action mailed 8/2/00, and applicant has yet present a convincing argument as to why this analysis is incorrect, for the reasons set forth in the Office actions mailed 2/27/01 and 5/17/01.

4. No claim is allowed.

5. Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The FAX numbers are (703) 308-4242 and (703) 308-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Unofficial papers, such as draft responses, may be transmitted to the examiner directly at (703) 305-7939. It is recommended that the examiner be notified when a fax is sent to this number.

Any inquiry concerning this communication or earlier communications should be directed to Thom Larson, whose telephone number is (703) 308-7309. The examiner normally can be reached Monday through Friday from 9:00 AM to 5:30 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached at (703) 308-0447.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist, whose telephone number is (703) 308-0196.

Thomas G. Larson, Ph.D.  
Examiner

JOHN L. LeGUYADER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600